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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,594	02/15/2001	Edward O. Wolf	80018A/PRC	8288

7590 01/27/2005

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EXAMINER	
VIEAUX, GARY	

ART UNIT	PAPER NUMBER
2612	

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/781,594	WOLF ET AL.	
	Examiner	Art Unit	
	Gary C. Vieaux	2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 September 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 September 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Change of Examiner

The prosecution of this application has been transferred to Examiner Gary C. Vieaux from the docket of Examiner Jeremy R. Elder. Any inquiry concerning this or earlier communications should be directed to the current Examiner of record. Current contact information is provided in the last section of this communication.

Amendment

The Amendment filed September 27, 2004 has been received and made of record. In response to the first office action, Applicant has amended the specification and drawings.

The Examiner finds the amendments to specification to better clarify the specification and are not found to add new matter.

The Examiner further finds the amendments to drawings, with respect to reference number 36 of figure 1, to properly indicate the interface cable referenced in the Detailed Description of the Invention. Therefore, the objection to the Drawings, with respect to reference number 36, is hereby withdrawn.

With respect to reference number 28 of figure 1, the Examiner finds description of the number to be provided for in the Parts List on page 16, as indicated by the Applicant on page 5 of the Remarks. Although the Examiner did not find an additional description on page 13 line 26, as indicated by the Applicant on page 5 of the Remarks,

additional description was found on page 14 line 11 of the specification. Therefore, the objection to the Drawings, with respect to reference number 28, is hereby withdrawn.

Response to Arguments

Applicant's arguments filed on September 27, 2004 have been fully considered but are not found persuasive.

Regarding claim 1, Applicant contends, on pages 6-7 of the Remarks, that the collective teachings of the Schelling and Watanabe references "fail to teach or suggest a host computer that recognizes the presence of both a digital image and an audio data segment in a given image file stored in a digital camera memory, and produces separate icons on its display for the digital image and the audio data segment." The Examiner respectfully disagrees.

Claim 1, as currently written, only provides for the host computer to recognize "the presence of the digital image and the at least one audio data segment in the memory" (section (b) of claim 1.) There is nothing found within claim 1 to support that the host computer also "produces separate icons on its display for the digital image and the audio data segment", as argued by the Applicant on page 7 of the Remarks. The method of claim 1 only provides for "producing at least two icons which are provided on a display associated with the host computer and which respectively represent the digital image and the at least one audio data segment."

The Applicant, on page 7 of the Remarks, also states "The Examiner at page 3, paragraph 5, of the Office Action acknowledges that such type indicator icons are for

purposes of providing a visual indication only, and cannot be selectively accessed to cause the transfer of any particular file from a memory to a host computer as claimed." The Office Action at page 3, paragraph 5 states " However, Schelling et al. do not disclose using an icon to select an image or audio file for transfer to the host computer." Based on a plain text interpretation of the relevant paragraph and for the purposes of maintaining a clear record regarding Examiner statements, the current Examiner of record respectfully disagrees with the Applicant's reading of the prior Examiner's acknowledgments in the previous Office Action.

The Applicant further states on page 7 of the Remarks, that Schelling's teaching in col. 3 line 62 – col. 4 line 4, "that an operator of the computer 50 must manually enter the type indicators corresponding to icons 28 and 30", is believed to be a direct teaching away from the claimed invention, because it "calls for the host computer to recognize the presence of both a digital image and an audio data segment in a given image file stored in a digital camera memory, and to produce separate icons on its display for the digital image and the audio data segment." For the above stated reasons regarding the functions of the host computer as provided for in section (b) of claim 1, the Examiner respectfully disagrees. It is also noted, that Schelling does provide for an icon indicating the type of data contained in the file to be automatically selected from a data file type indicator in the digital data and added to the index image (col. 3 lines 15-18.)

It is also argued by the Applicant on page 8 of the Remarks, that Watanabe does not provide a teaching "regarding the claimed host computer recognizing the presence of both a digital image and an audio data segment in a given image file stored in a

digital camera memory, and producing separate icons on its display for the digital image and the audio data segment." Again, the Examiner respectfully disagrees. Claim 1, as currently written, does not provide for the host computer to both "recognize" and "produce". Claim 1 only provides that "...the host computer identifies the at least one image file, recognizing the presence of the digital image and the at least one audio data segment in the memory" (section (b) of claim 1.)

Applicant also asserts, on page 8 of the Remarks, that the Examiner has failed to establish a *prima facie* case of obviousness for claim 1. Applicant points to page 4 of the Office Action, which provides:

> It would have been obvious to one of ordinary skill in the art at the time of invention to combine the "drag and drop" method of Watanabe et al. with the invention of Schilling (sic) et al. to create a system of allowing the user select (sic) which images or audio clips to transfer from the memory by selecting the corresponding thumbnail to a host computer for the benefit of organizing the images and audio clips on the host computer by thumbnail while freeing limited storage of the camera.

Upon review of Watanabe for motivation to combine the functionality of "drag and drop" selectivity to the invention of Schelling, specific reference to combine can be found at col. 6 lines 64-67, in which the user is allowed to select and review merely the necessary image data without copying the entire data stored in the unit to memory, and at col. 7 lines 21-23, in which the user may free limited storage through the ability to

erase copies of the data in the camera (col. 7 lines 21-23.) When faced with the problem of selective accessibility, one of ordinary skill in the art at the time of the invention would have turned to the solutions of others within the art who have been faced with similar problems. Watanabe is found to provide selective accessibility solutions, as well as being found to indicate resulting benefits (col. 6 lines 64-67, where one does not need to copy the entire data; and col. 7 lines 21-23, where the user may free storage space by erasing copies.) The benefits receive, as presented in the previous Office Action and clarified in the instant Office Action, are found by the Examiner to be clearly delineated motivation for combination, and therefore, the Examiner respectfully disagrees with the Applicant's assertions.

Regarding claims 2-6, the Examiner respectfully disagrees with Applicant's arguments concerning dependent claims 2-6, for at least the reasons identified above in relation to their motivational reliance on independent claim 1. Claims 2-6 are therefore rejected as previously presented in the Office Action dated June 21, 2004.

Additionally, Applicant asserts, on page 10 of the Remarks, that The Shiohara and Xu references, as combined with Schelling and Watanabe, also fail to establish a *prima facie* case for their respective combinations, by providing "only conclusory statements of motivation".

Regarding claim 5, Shiohara is combined with Schelling and Watanabe, for the purpose of enhancing the invention of Schelling and Watanabe. Such an enhancement would undoubtedly be derived as presented in the previous Office Action. The desire to

achieve a fuller representation of the data through accessing of the icon, which is taught by Shiohara, would clearly motivate one of ordinary skill in the art at the time of the invention to integrate those same teachings within the invention as taught by Schelling and Watanabe. Because the motivation provided in the previous Office Action is establishes reasonable motivation for combination, the Examiner respectfully upholds the earlier 103(a) rejection to claim 5.

Regarding claim 6, Xu is combined with Schelling and Watanabe, for the purpose of enhancing the invention as taught by Schelling and Watanabe. The previous Office Action, on page 5 – page 6, provides:

> It would have been obvious to one of ordinary skill in the art at the time of invention to have the operating system of the computer recognize the contents of the memory card of the camera as an auxiliary drive for the benefit of not requiring the memory card to be removed from the camera simplifying the transfer of images and audio from the camera.

The Examiner recognized that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, the test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). References as evaluated by what they suggest to one versed in the art, rather than by their respective disclosures. In re Bozek, 163 USPQ 545 (CCPA 1969). In this case, through the teachings of Xu, it would have

been obvious to one of ordinary skill in the art at the time of invention that the resulting combination would obviate the requirement of removing the memory card from the camera when transferal of images was desired. The addition of the ability to recognize the contents of the memory card of the camera as an auxiliary drive, for the purpose of not requiring the memory card to be removed from the camera in order to transfer images, is a clear motivational benefit derived from the combination. Therefore, the Examiner respectfully upholds the earlier 103(a) rejection to claim 6.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Vieaux whose telephone number is 703-305-9573 until March 1, 2005, and 571-272-7318 afterwards. The examiner can normally be reached during his normal office hours, which are Monday - Friday, 8:00am - 4:00pm, with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber (SPE 2612) can be reached at 703-305-4929 until March 1, 2005, and at 571-272-7308 afterwards. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gary C. Vieaux
Examiner
Art Unit 2612

Gcv2

TUAN HO
PRIMARY EXAMINER